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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,128	03/11/2004	Naveenkumar Vishwanath Muguda	RSW920030302US1	8794
48816 7590 12/24/2008 IBM CORPORATION - RSW (JVL) C/O VAN LEEUWEN & VAN LEEUWEN P.O. BOX 90609 AUSTIN, TX 78709-0609				
EXAMINER				
ANWARI, MACEEH				
ART UNIT		PAPER NUMBER		
2444				
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12/24/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/798,128

**Applicant(s)**

MUGUDA ET AL.

**Examiner**

MACEEH ANWARI

**Art Unit**

2444

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 6-10, 12-16 and 18-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6-10, 12-16, 18-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

#### **DETAILED ACTION**

1. This action is in response to communications file on 9/17/2008. **Claim(s) 2, 10, 16, 21 and 23-24** have been amended. No other claims have been amended, added, or canceled. Accordingly, **claim(s) 1-3, 6-10, 12-16 and 18-25** are pending.

#### ***Response to Arguments***

2. Applicant's arguments filed 9/17/2008 have been fully considered but they are not persuasive. In substance the applicant argues: 1) that claim 1 includes proper Markush claiming language and the 112 *lack of antecedent basis* rejection does not apply; 2) that **Gross** does disclose replying to a message using a rule sentence, but does not disclose forwarding the rule.

3. Regarding 1), the examiner respectfully disagrees. While the wording of the specific sentence might be in proper Markush form, the use of the terms "the group" renders the claim with a lack of antecedent basis. This could have been avoided by simply stating "a group consisting of a job description and an expertise." Therefore, the examiner will maintain the rejection.

4. Regarding 2), the examiner respectfully disagrees. Applicant employs broad language, and admits that the prior art of record discloses receiving a "rule" and furthermore admits that the prior art of record discloses forwarding a message and changing the email recipient address. Therefore, the received rule can be modified and forwarded. Applicant has had an opportunity to amend the claimed subject matter, and has failed to modify the claim language to distinguish over the prior art of record by clarifying or substantially narrowing the claim language. Thus, Applicant apparently

intends that a broad interpretation be given to the claims and the Examiner has adopted such in the present and previous Office action rejections. See *In re Prater and Wei*, 162 USPQ 541 (CCPA 1969), and MPEP 2111.

5. Applicant employs broad language, which includes the use of word, and phrases, which have broad meanings in the art. In addition, Applicant has not argued any narrower interpretation of the claim language, nor amended the claims significantly enough to construe a narrower meaning to the limitations. As the claims breadth allows multiple interpretations and meanings, which are broader than Applicant's disclosure, the Examiner is forced to interpret the claim limitations as broadly and as reasonably possible, in determining patentability of the disclosed invention. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir.1993).

6. Failure for Applicant to significantly narrow definition/scope of the claims and supply arguments commensurate in scope with the claims implies the Applicant intends broad interpretation be given to the claims. The Examiner has interpreted the claims with scope parallel to the Applicant in the response, and reiterates the need for the Applicant to more clearly and distinctly defines the claimed invention.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. **Claim 1- 3, 6-10, 12- 16 and 18-25** recites the limitation "the group consisting of a job description and an expertise". There is insufficient antecedent basis for this limitation in the claim.

9. Furthermore regarding **claims 2, 10 & 16** they recite the limitation "the collaborative discussion". There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. **Claims 1- 3, 6-10, 12- 16, and 18- 25** are rejected under 35 U.S.C. 102(b) as being anticipated by **Gross et al.** (hereinafter-**Gross**) U.S. Patent No.: 5,283,856.

**Claim 1:** A computer implemented method comprising:

receiving presentation content (Figures 1-2 and 6; e-mail) from an initiating client; identifying a plurality of users for which to participate in the presentation content (Figures 1-2, 6, 9 and 10A-B; e-mail messages, users and "To, From, CC, BCC" fields); distributing the presentation content to the identified plurality of users (Figures 1-2, 6, 9 and 10A-B; e-mail messages and sending them to users); after distributing the presentation content, receiving a first message from one of the plurality of users that includes a rule (Figures 1-2, 6, 9 and 10A-B; "To" field—address to where the message is being sent), the first message

associated with the distributed presentation content but sent separately from the distributed presentation content (Figures 11- 11A; reply to the e-mail), wherein the rule includes a rule sentence that is selected from the group consisting of a job description and an expertise; (Figures 11- 11A; user and department); identifying a subset of the plurality of users that correspond to the rule (Figures 11- 11A; reply to the e-mail); forwarding the first message and the rule to the identified subset of users (Figures 11- 11A; replying to the e-mail and forwarding the e-mail); receiving a second message and a modification of the forwarded rule from one of the identified users, wherein the modified forwarded rule includes a different rule sentence that is selected from the group consisting of a different job description and a different expertise; identifying one or more subsequent users that correspond to the modified forwarded rule; (Figures 1-9 and Abstract & Par. 40; mail messaging, users , rules and rule sets and attachments); and sending the second message and the modified forwarded rule to the one or more subsequent users that correspond to the modified forwarded rule (Figures 9-11 and Abstract & Col. 10 lines 44-51; mail messaging, users and sending messages).

**Claim 2:** Wherein the first message includes a comment, and wherein comment is displayed in the same display window as the collaborative discussion (Figures 9-11 and Abstract; mail messaging and message text).

**Claim 3:** Wherein the comment is displayed using display attributes corresponding to a rule pen, the rule pen that includes one or more rules, one of

the rules being the forwarded rule (Figures 9-11 and Abstract; mail messaging, message text and rule, rule engine, rule editor and rule data base).

**Claim 6:** Wherein the rule sentence includes a rule sentence value, and wherein the rule sentence value is selected from the group consisting of a term, a constant, a connective and a function (Figures 1-11A and Abstract & Col. 4 lines 33-45; rule set, rule data base and multiple functions).

**Claim 7:** Wherein the modifying includes changing the number of rule sentences that correspond to the rule (Figures 9-11 and Abstract; rule editor and multiple users).

**Claim 8:** Wherein the received message is sent from a sending client, the sending client adapted to select a rule pen from a rule pen stand, wherein the rule pen includes one or more rules, the forwarding rule being one of the rules (Figures 9-11A and Abstract & Col. 10 lines 44-51; rule, rule set, mail messaging, users, sending messages and users).

**As per claims 9- 10 & 12- 14**, the claims are directed to a system including substantially similar limitations to those recited in the method of **claims 1- 3 & 6- 8**. Therefore, the supporting rationale of the rejection to **claims 1- 3 & 6- 8** applies equally as well to **claims 9- 10 & 12- 14**.

**As per claims 15-16 & 18- 20**, the claims are directed to a computer operable medium including substantially similar limitations to those recited in the

method of **claims 1- 3 & 6- 8**. Therefore, the supporting rationale of the rejection to **claims 1- 3 & 6- 8** applies equally as well to **claims 15-16 & 18- 20**.

**As per claims 21-22**, the claims are directed to a method including substantially similar limitations to those recited in the method of **claim 1**. Therefore, the supporting rationale of the rejection to **claim 1** applies equally as well to **claims 21-22**.

**As per claim 23**, the claims are directed to a system including substantially similar limitations to those recited in the method of **claim 1**. Therefore, the supporting rationale of the rejection to **claim 1** applies equally as well to **claims 23**.

**As per claims 24-25**, the claims are directed to a program product including substantially similar limitations to those recited in the method of **claim 1**. Therefore, the supporting rationale of the rejection to **claim 1** applies equally as well to **claims 24- 25**.

**Examiner Note:** Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in its entirety as potentially teaching of all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

#### ***Conclusion***

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).



A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MACEEH ANWARI whose telephone number is (571)272-7591. The examiner can normally be reached on Monday-Friday 7:30-5:00 PM ES.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Vaughn can be reached on 571-272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

M.A.  
/William C. Vaughn, Jr./  
Supervisory Patent Examiner, Art Unit 2444